IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BAUM et al.

Application No.: 09/450,075

Filed: 11/29/1999

For: PRINTING IMAGES IN AN
OPTIMIZED MANNER

Examiner: Rahimi, Iraj A

Art Unit: 2622

AFTER FINAL RESPONSE

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313

Sirs:

The Final Office Action of July 28, 2004 withdrew the objection to the drawings but maintained its rejections under Sections 102 and 103. In view of the arguments below, Applicants submit that all claims are in condition for allowance. Withdrawal of the rejection is requested.

The Section 102 Rejection

The Final Office Action maintained the Section 102 rejection using Fredlund (USPN 5,666,215). The Final Office Action stated that

Applicant argues that Fredlund does not teach receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient. Examiner disagrees and cites column 6, lines 29-41 were Fredlund discloses when order for a particular images are placed customer actuates the "done" button and can proceed to place another order which can be for another recipient. When customer has completed placing orders customer actuates the "place order" button, which

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advances to payment screen. "This facilitates sending the same image to different addresses (or different recipients) in screen 68 without re-editing the image." Since Fredlund teaches more that one recipient address, it suggests more than one recipient. Therefore Fredlund can meet the claim limitation for plurality of recipients. Fredlund also discloses in column 5, lines 32-47 that customer selects among the images the desired images to have printed. Page 2 of Final Office Action.

Applicants respectfully traverse the rejection. Even though customers can actuate the "done" button for each customer and repeat the ordering process, Fredlund does not show receiving an order specifying a plurality of recipients in one step. Hence, Fredlund cannot anticipate the independent claims as well as those dependent therefrom.

On page 3, the Final Office Action acknowledged that Fredlund disclosed in his invention that orders for each recipient are entered one at a time. The Examiner's characterization of Fredlund actually supports Applicants' position since Fredlund can only place an order for one recipient at a time and must repeat the ordering process for each recipient. Fredlund cannot receive an order specifying a plurality of recipients all in one step. Hence, the claims are allowable for at least this reason.

The Office Action further noted that:

Applicant also argues that newly amended claim includes the limitation for generating a contiguous run of prints for each recipient specified by the order in not taught by Fredlund. Examiner disagrees and cites column 8, lines 56-63 which describes the end of the print ordering method by stating that images are retrieved from the tape library and printed. Fredlund discloses in his invention that orders for each recipient is entered one at a time and once all images for all recipients are selected it collects the payment information and starts printing the desired images for each recipient. It is also obvious that prints for each recipient will be printed contiguously otherwise all prints will be mixed together and it would be very difficult to sort the prints for each recipient as well as being counter intuitive.

The response provided above applies equally to the arguments for claims 35 and 43.

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Applicants respectfully traverse the rejection. A Section 102 rejection requires that each and every element be present in the reference. In this case, the Office Action acknowledged that the element is not disclosed in the reference and relied on information outside of the reference as follows: "It is also obvious that prints for each recipient will be printed contiguously otherwise all prints will be mixed together and it would be very difficult to sort the prints for each recipient as well as being counter intuitive." There is no support for the Section 102 rejection and this is an independent reason for traversing the rejection.

A Section 102 rejection requires each and every element to be present. Here, Fredlund fails to show a number of elements. First, Fredlund fails to show receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient.

Moreover, another independent basis for traversing the rejection is that Fredlund fails to show separating the images associated with the recipient into at least one printable unit of images to generate a contiguous run of prints for each recipient specified by the order.

Since at least two elements are not shown in Fredlund, the Section 102 rejection of independent claim 1 is improper and should be withdrawn. Moreover, claims that depend therefrom are not anticipated by Fredlund.

With respect to claim 35, Fredlund does not show receiving an order specifying one or more a plurality of recipients and, for each specified recipient, a set of digital content associated with that recipient; for each recipient specified by the order, separating the digital content associated with the recipient into at least one generatable unit of digital content having a contiguous run of prints for the recipient; and for each generatable unit of digital content, generating a physical manifestation of the unit of digital content.. Fredlund's Col. 5, lines 35-51 does not show the scheduler but teaches that:

> If there are more images in the file than can be shown in the column 52, the other images can be displayed by activating a scroll bar 54 to scroll the images in the column. To select one of the images from the digital image file, the customer selects the desired print size and quantity in area 76. Display area 56 assumes the correct aspect ratio for the desired final print size. The customer then identifies one of the images using a standard drag and drop computer interface or set-top box selection mode, for example by clicking on one of the images with a mouse or trackball and dragging it into the large display area 56, or by entering the desired frame number on a remote control device if the program is implemented via a set-top box. The customer can thereby use the computer data entry

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